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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,688	03/01/2004	Jeffrey Bergh	HARD1.072A	2600
20995	7590	10/11/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			KENNEDY, JOSHUA T	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*He*

## Office Action Summary

Application No.

10/791,688

Applicant(s)

BERGH ET AL.

Examiner

Joshua T. Kennedy

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*JK*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/19/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19,25-45 and 68-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,25-45 and 68-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/1/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-19, 25-45, and 68-78 have been examined.

Examiner acknowledges applicant's claim for priority from Application No: 60/451,341 with a filing date of February 28, 2003.

#### ***Claim Objections***

Claim 4 is objected to because of the following informalities:

Claim 4, line one refers to "The fence system of Claim 4" this should be -- The fence system of Claim 3--.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 15, 25, 34, 35, 43, and 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Each of these claims refers to the terms "substantial" or "substantially". It is unclear and indefinite to what degree applicant considers "substantial". Further clarification is required

Claims 38, 39-41, 73 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of these claims refers to the term "about". It is an indefinite term and it is unclear what numerical value constitutes "about". Further clarification is required

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19, 25-45, and 68-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newberry, Jr. (US 3,801,072) in view of Gleeson et al (US Patent Application Publication 2001/0047741).

As to Claims 1-4, 9-12, 15-17, 25, 26, 31, 34-36, 42, 68, 70, and 72. Newberry, Jr. discloses a fence system, comprising:

a mounting surface (20); and

a plurality of individual elongate members or pickets (11) attached to the mounting surface and aligned in a manner so as to form a barrier, wherein the at least one individual member being made into a desired shape for use in a fence prior to curing (Col 1, Lines 35-43), and the at least one individual member having at least one surface that has a pre-finish thereon resembling a wooden picket (Col 1, Lines 29-43); said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1; Col 3, Lines 61-64).

Newberry Jr. does not disclose at least one individual member made of fiber cement whereby the at least one individual member does not exhibit any substantial fraying of the fibers along surfaces of the at least one individual member after curing. Wherein the fiber cement forming the at least one individual member incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the fence panel and pickets as taught by Newberry to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including

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fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

As to Claims 5, 19, 69, and 75. Newberry Jr. discloses the at least one individual member having a first end, said first end being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1—Shows the pickets with a dog-eared shape).

As to Claims 6, 7, 27, 32 and 76-78. Newberry Jr. discloses the at least one individual member having a first surface, wherein the first surface has a finish that is capable of resembling wood or the color thereof or masonry (Col 1, Lines 39-43).

As to Claims 8 and 28. Newberry Jr. discloses the at least one surface comprising two opposing sides of the individual member (Col 3, Lines 45-58).

As to Claims 13, 14, 43, and 44. Newberry Jr. discloses the mounting surface comprising a pair of mounting rails (20) having a longitudinal axis, and the at least one individual member is positioned in a manner such that a longitudinal axis of the individual members (or pickets) is substantially perpendicular to the longitudinal axis of

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the mounting surface, wherein a first mounting rail is secured to the pickets at an upper location of the pickets, and a second mounting rail is secured to the pickets along a lower location of the pickets (Fig 4).

As to Claim 18. Newberry Jr. discloses the at least one individual member having at least one surface that is embossed with a pattern (Col 1, Lines 39-43).

As to Claims 29 and 30. Newberry Jr. discloses at least one exterior surface of the picket being stained or being textured (Col 1, Lines 39-43).

As to Claim 33. Newberry Jr. discloses the picket capable of being nailed onto a fence rail (Col 4, Lines 27-30).

As to Claims 39, 71, and 73. Newberry Jr. discloses a fence system wherein each of said pickets has a length between about 6 and 8 feet (Col 2, Lines 5-7).

As to Claim 45. Newberry Jr. discloses at least two posts, each of said posts having an elongate configuration extending between an upper end and a lower end and being substantially parallel to the pickets, said posts being secured to the mounting rails, wherein the lower ends of the posts extend below the lower ends of the pickets to secure the posts in a ground location (Fig 4; Col 4, Lines 13-15).

As to Claims 37 and 38. Newberry Jr. does not disclose a fence system wherein each of said pickets has an aspect ratio of between 4 and 12 and are spaced from one another by a distance of between about  $1/2$  and 1 inch. However, it is not inventive to state the optimum or workable values of the size of the blocks. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have an aspect ratio of between 4 and 12 and be spaced from one another by a distance of between about  $1/2$  and 1 inch so as to achieve the desired aesthetic appearance.

As to Claims 40 and 74. Newberry Jr. does not disclose a fence system wherein each of said pickets has a width between about 4 and 12 inches. However, it is not inventive to state the optimum or workable values of the size of the blocks. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a width between about 4 and 12 inches so as to achieve the desired aesthetic appearance.

As to Claim 41. Newberry Jr. does not disclose a fence system wherein each of said pickets has a thickness of between about  $5/16$  and  $3/4$  inch. However, it is not inventive to state the optimum or workable values of the size of the blocks. As determined through routine experimentation and optimization, it would have been obvious to one of



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ordinary skill in the art to dimension each of said pickets to have a thickness of between about 5/16 and 3/4 inch so as to achieve the desired aesthetic appearance.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,883,786 to Bebendorf cited to show a fence post and rail assembly having pickets that is capable of being constructed with fiber cement.

USPN 5,452,968 to Dlugosz cited to show a fiber cement construction capable of being used in a fencing system.

USPN 2,721,727 to Eddy III cited to show a wooden picket construction having pickets mounted on rails between two posts.

USPN D252,406 to Dobias cited to show a fence having a plurality of different shapes on one end.

US Patent Application Publication 2002/0059886 to Merkley et al cited to show a method of forming a fiber cement structure, which is capable of being used in fencing construction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large, looped initial "D".

JTK  
9/28/2005

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600